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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,869	01/16/2004	Nusrallah Jubran	3216.63US01	8013
24113 7590 02/22/2008 PATTERSON, THUENTE, SKAAR & CHRISTENSEN, P.A. 4800 IDS CENTER 80 SOUTH 8TH STREET MINNEAPOLIS, MN 55402-2100				
EXAMINER				
DOTTE, JANIS L				
ART UNIT		PAPER NUMBER		
1795				
MAIL DATE		DELIVERY MODE		
02/22/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/758,869

Applicant(s)

JUBRAN ET AL.

Examiner

Janis L. Dote

Art Unit

1795

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-12 and 14-16 is/are rejected.
- 7) ☒ Claim(s) 5 and 13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Individual Patent Application
- 6) ☒ Other: See Continuation Sheet
- Paper No(s)/Mail Date _____

Continuation of Attachment(s) 6). Other: Initial Interview Request Form 2/8/08 and 02/13/08.

1. The finality of the rejection of the last office action mailed on Nov. 6, 2007, has been withdrawn.
2. The indicated allowability of claims 1-16 has been withdrawn in view of the newly discovered reference to US 7,320,849 B2 (Jubran'849). Rejections based on the newly cited reference follow.
3. The amendment filed on Feb. 6, 2008, after the final office action mailed on Nov. 6, 2007, has been entered. The examiner acknowledges the amendments to claims 1, 5, 9, and 13 and the cancellation of claims 26-30 filed on Feb. 6, 2008. Claims 1-16 are pending.
4. Because the amendment filed on Feb. 6, 2008, has been entered, applicants' request filed on Feb. 13, 2008, for a telephonic interview to discuss the entry of said amendment is rendered moot. Therefore, applicants' request for an interview on Feb. 19, 2008, has been denied. (The examiner also notes that applicants' request filed on Feb. 8, 2008, for a telephonic interview to discuss the same topic on Feb. 18, 2008, has been denied for the reasons discussed above; and because Feb. 18, 2008, is a Federal holiday and the USPTO is closed on that day.)

5. The objection to the specification set forth in the office action mailed on Nov. 6, 2007, paragraph 3, has been withdrawn in response to the amended paragraphs beginning at page 3, line 19, page 4, line 28, page 10, line 6, and page 23, line 20, of the specification, filed on Feb. 6, 2008.

The rejections of claims 1-16 and 26-30 under 35 U.S.C. 112, second paragraph, set forth in the office action mailed on Nov. 6, 2007, paragraph 5, have been withdrawn in response to the amendments to claims 1 and 9 and the cancellation of claims 26-30 filed on Feb. 6, 2008.

The prior art rejections of claims 26-30 set forth in the office action mailed on Nov. 11, 2007, paragraphs 8 and 9, have been mooted by the cancellation of claims 26-20 filed on Feb. 6, 2008.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the

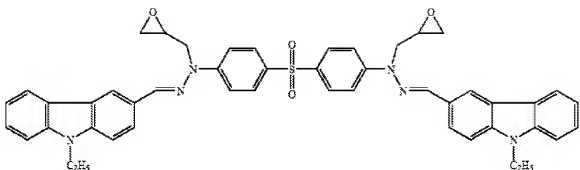
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United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-4, 6-12, and 14-16 are rejected under 35 U.S.C. 102(e) as being anticipated by US 7,320,849 B2 (Jubran'849).

Jubran'849 discloses an organophotoreceptor and an image forming apparatus comprising said organophotoreceptor. The apparatus further comprises a light imaging component and a liquid toner dispenser, as recited in instant claims 9 and 16, respectively. Col. 3, lines 23-30. The organophotoreceptor comprises an electrically conductive substrate and a photoconductive element on the substrate. The photoconductive element comprises a charge generation material and a charge transport material of the general formula disclosed at col. 2, line 55, to col. 3, line 14. See col. 2, line 49, to col. 3, line 14. Jubran'8409 teaches that the charge transport material of said general formula can be represented by the particular compound of formula (3) described at cols. 17 and 18 and shown below:

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The charge transport material of formula (3) meets the compositional limitations of the formula recited in instant claims 1-4 and 9-12. The Jubran'849 charge transport material is represented by the formula recited in the instant claims when:

- (1) E_1 and E_2 are

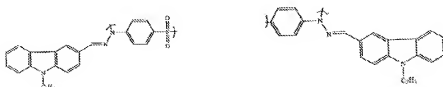


an oxiranyl ring, as recited in instant claims 4 and 12.

- (2) X_1 and X_2 are both a methylene group, as recited in instant claims 3 and 11.

- (3) Y_1 and Y_2 , are respectively,

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and

The above Y groups meet the limitation "comprise . . . a carbazoyl group" recited in instant claims 1 and 9. The term "comprise" is open and includes carbazoyl groups and groups that comprise a carbazoyl, such as the above Y groups.

(4) Z "is a bond," as recited in instant claims 2 and 10, that bonds the two above Y groups together.

Jubran'849 further teaches that the photoconductive element can comprise a binder resin as recited in instant claim 8 and an electron transport material, as a second charge transport material, which meets the limitations recited in instant claims 6, 7, 14, and 15. Col. 3, lines 18-21; col. 10, lines 42-46; and reference claims 8, 9, 18, and 19.

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would

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have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

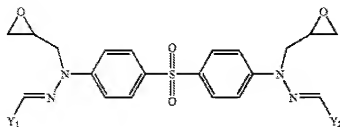
9. Claims 1-4, 6-12, and 14-16 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 7,320,849 B2 (Jubran'849).

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed subject matter recited in Jubran'849 renders obvious the subject matter recited in the instant claims.

Reference claim 16, which depends from reference claim 11, recites an electrophotographic imaging apparatus comprising an organophotoreceptor and a light imaging component. The organophotoreceptor comprises an electroconductive substrate and a photoconductive element that comprises a charge generation

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material and a charge transport compound represented by the formula



where Y_1 and Y_2 are, each independently, an arylamine group. Reference claim 14, which depends from reference claim 11, recites that the Y groups can be a carbazolyl group.

When Y_1 and Y_2 in the formula of reference claim 16 are each a carbazolyl group as recited in reference claim 14, the charge transporting material is represented by the formula recited in the instant claims when:

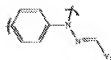
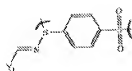
- (1) E_1 and E_2 are



an oxiranyl ring, as recited in instant claims 4 and 12.

- (2) X_1 and X_2 are both a methylene group, as recited in instant claims 3 and 11.

- (3) Y_1 and Y_2 , are respectively,



and , where Y_1 and Y_2 are each a carbazoyl group. The above Y groups meet the limitation "comprise, each independently, a carbazoyl group" recited in instant claims 1 and 9. The term "comprise" is open and includes carbazoyl groups and groups that comprise a carbazoyl, such as the above Y groups.

(4) Z "is a bond," as recited in instant claims 2 and 10, that bonds the two above Y groups together.

Reference claim 19, which depends from reference claim 18, which in turn depends from reference claim 10, requires that the photoconductive element further comprise an electron transport compound, which meets the second charge transport limitations recited in instant claims 6, 7, 14, and 15. Reference claim 20, which depends from reference claim 10, requires that the imaging apparatus further comprise a liquid toner dispenser as recited in instant claim 16. Reference claim 10, which depends on reference claim 1, which recites an organophotoreceptor that is identical to that recited in reference claim 11, requires that

the photoconductive element further comprise a binder resin as recited in instant claim 8.

It would have been obvious for a person having ordinary skill in the art, in view of the subject matter recited in the claims of Jubran'849, to make and use the charge transporting material in reference claim 16, wherein the Y groups are carbazolyl groups as recited in reference claim 14, such that the resultant charge transporting material is within the compositional limitations of the formula recited in the instant claims, and to use the resultant compound as the charge transport material in the organophotoreceptor in the imaging apparatus recited in the claims of Jubran'849. That person would have had a reasonable expectation of successfully obtaining a charge transport material that is capable of transporting charges in an organophotoreceptor, and an organophotoreceptor and an electrophotographic imaging apparatus that are capable of being used in an electrophotographic process to provide toned images.

10. Claims 5 and 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art, in particular Jubran'849, does not disclose or suggest an organophotoreceptor comprising a charge transport material represented by the formula recited in instant claims 5 and 13.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janis L. Dote whose telephone number is (571) 272-1382. The examiner can normally be reached Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Mark Huff, can be reached on (571) 272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry regarding papers not received regarding this communication or earlier communications should be directed to Supervisory Application Examiner Ms. Sandra Sewell, whose telephone number is (571) 272-1047.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Janis L. Dote/
Primary Examiner, Art Unit 1795